Remarks

The above Amendments and these Remarks are in reply to the Final Office Action mailed May 10, 2007. No fee is due with this REPLY.

A. Withdrawal of Claims 8-17

The Examiner withdrew claims 8-17 as directed to inventions considered to be independent or distinct from the invention originally claimed. Claim 8 has been amended to depend from claim 1 and claim 13 has been amended to depend from claim 3. Claims 9-12 now depend ultimately from claim 1 and claims 14-17 now depend ultimately from claim 3. Thus, all claims presented are drawn to the same invention. Applicants respectfully request that claims 8-17 be rejoined into the application.

B. Rejections under 35 U.S.C. §112, second paragraph

Claims 1-6 stand rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1, 3, and 5 stand rejected under 35 U.S.C. §112, second paragraph due to the recitation "to **produce a prognosis** of an outcome of a disease or its treatment" (emphasis added). The Examiner asserted:

> Due to the use of passive language, it is unclear if this limitation is intended to be an active method step (i.e. producing a prognosis), an intended use or otherwise. Correction is requested via clearer claim language. (Final Office Action, p. 4, 4th para.)

Claims 1, 3, and 5 have been amended to recite "to **predict** an outcome of a disease or its treatment" (emphasis added). Claims 1, 3, and 5 therefore are now definite. Thus Applicants believe that the amendment overcomes the Examiner's rejection. Further, Applicants respectfully submit hat the amendments do not add any limitations not already present in the claims, and therefore, no new search is required.

Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §112, second paragraph be withdrawn.

C. Rejections under 35 U.S.C. §102

Claims 1-6 stand rejected under 35 U.S.C. §102(b) as anticipated by Barry et al. (U.S. Patent No. 6,081,786; hereafter, "Barry"). Claims 1-6 stand rejected under 35 U.S.C. §102(b) as anticipated by Slonim et al.

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1.   **Barry**

Barry discloses:

> Systems, methods and computer programs for guiding selection of a
> therapeutic treatment regimen for a known disease such as HIV infection....
> The method comprises... providing patient information to a computing
> device... comprising a first knowledge base comprising a plurality of
> different treatment regimens for the disease; a second knowledge base
> comprising a plurality of expert rules for selecting a therapeutic treatment
> regimen for the disease; and a third knowledge base comprising advisory
> information useful for the treatment of a patient.... (Abstract, lines 1-11)

Barry discloses:

> A listing (preferably a ranked listing) of therapeutic treatment regimens for a
> patient is generated in the computing device. Advisory information for one
> or more treatment regimens in the listing is generated in the computing
> device based on the **patient information** and the expert rules. (col. 2, lines
> 60-64; emphasis added)

Thus, Applicants submit that Barry discloses a **single** prediction based on patient information but does not

disclose a method for "combin[ing]...prediction derived from... classified gene expression data and...

prediction derived from... classified clinical information...." By contrast, Applicants' claims are directed to a

combined prediction based on two independent predictions.

2.   **Slonim**

Slonim discloses:

> a method for classifying samples by computational analysis of **gene
> expression data**. We consider the classification problem in two parts: *class
> discovery* and *class prediction*. Class discovery refers to the process of
> dividing samples into reproducible classes that have similar behavior or
> properties, while class prediction places new samples into already known
> classes. We describe a method for performing class prediction and illustrate
> its strength by correctly classifying bone marrow and blood samples from
> acute leukemia patients. (Abstract, lines 2-12; boldface emphasis added;
> italics emphasis in original)

Thus, Applicants submit that Slonim discloses a **single** prediction based on patient information but does not

disclose a method for "combin[ing]...prediction derived from... classified gene expression data and...

prediction derived from... classified clinical information...." By contrast, Applicants' claims are directed to a

combined prediction based on two independent predictions.

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3. Cited Art Does Not Anticipate Applicants' Amended Claims

Independent claims 1, 3 and 5 have been amended to recite "combin[ing]...prediction derived from... classified gene expression data and... prediction derived from... classified clinical information...." As can be seen from the amendment, Applicants' systems and methods **combine** independent predictions to arrive at an overall prediction. Applicants respectfully submit that the cited art does not anticipate Applicants' amended claims. All of the dependent claims incorporate the above limitations, so none of the dependent claims are anticipated by Barry or Slonim. Accordingly, Applicants respectfully request that the rejections under 35 U.S.C. §102 be withdrawn.

D. Conclusion

Based on the amendments and arguments presented, Applicants respectfully submit that none of the references cited anticipate Applicants' claims, and that all of the pending claims are allowable. Further, because the amendments to the claims did not introduce additional limitations, Applicants respectfully submit that no new search is needed. Applicants respectfully request the Examiner to enter the amendment, reconsider the rejections, to find the claims allowable, and to provide a Notice of Allowability.

The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

Respectfully submitted,
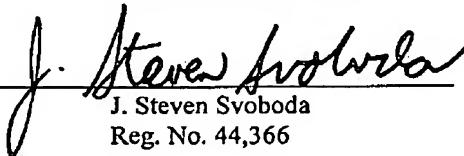
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